

#### **IV. REMARKS**

##### **Status of the Claims**

Claims 1-19 are presented for further consideration.

##### **Summary of the Office Action**

Claims 1-3, 5-14, and 16-19, stand rejected under 35USC102(b) on the basis of the cited reference Wang, U.S. Patent No. 5,917,913. Claims 2-4, and 15 stand rejected under 35USC103(a) based on the reference Wang in view of the cited reference McGregor ,et al, U.S. Patent No. 5,625,669. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

##### **The Invention**

As described in the claims under consideration, the device of this application provides a means for completing a transaction at a point of sale device using a portable communication device. In the device of this invention there are two separate communications set up, one that is used for transmitting transaction information and another (the identification means) that is used for transmitting identification information relating to the particular communication device. The identification means is a separate link and may be as simple as a bar code readable by the point of sale device. The identification means enables the communication using, for example, a cellular communication network. The cited reference Wang fails to show such a system.

### **Discussion of the Cited Reference**

The Examiner relies on the reference Wang as support for the rejection based on anticipation and as primary support for the rejection based on obviousness.

Wang discloses a system for approving a transaction request between an electronic transaction system 202 (e.g. an ATM) and a portable electronic authorization device 200 (PEAD). A path 206 is set up between port 204 of ATM 202 and PEAD 200. Communication path 206 can be infrared or any other type of communication link. A transaction is initiated by a request from ATM 202. A response indicating approval or rejection of the request is sent from PEAD 200 to ATM 202 via path 212 to port 204. The response includes the users identification data (see column 4, lines 47-48. There is therefore no identification means separate from the communication means as required by the claims of this application.

With reference to figure 4 and column 4, lines 41-55, the Examiner has asserted that the PEAD's user identification data 410 corresponds to the "identification means" of claim 1; and with reference to figure 6B, has asserted that the PEAD's infrared transceiver 662 of Wang corresponds to the "communications means" of claim 1.

However, the user identification data 410 of Wang does not constitute the "identification means" as defined by claim 1 of the present application. Claim 1 describes the identification means as arranged to provide information on the portable communications device obtainable by the second device. The user identification data of Wang is not

obtainable by the receiving device 202, except when transmitted by the infrared transceiver 662 as part of a transaction response. The infrared transceiver 662 of Wang would have to be interpreted as an intrinsic and inseparable part of an identification means as defined by claim 1 of the present application. The same applies in the embodiments of Wang where the port 510 is an RF port, magnetic read/write head, etc. (column 9, lines 23-31; figure 5A). Therefore Wang does not teach identification means separate from the communications means as defined in the claims of this application.

The cited passage at column 4, lines 41-55 of Wang merely confirms this. Particularly, column 4, lines 47-50 states:

**"...which causes an approval message to be created with the user's identification data, encrypted and sent back to the requesting device 202 via path 212."**

The path 212 is the path from the port 204 (e.g. the infrared port) to the requesting device (see also, column 9, lines 23-38; figure 5A).

Similar comments apply to independent claims 16 and 17. Note that claim 17 recites:

**"one of said second device and said portable communications device obtaining information from the other of said second device and said portable communications device by an identification means, and using said information to establish communications between said second device and said portable communications device by a communications means separate to said identification means."**

Further, there is no suggestion in Wang that the information received from the infrared transceiver 662 is

used to establish communications, as in independent claims 1 and 16 of the present application, nor to establish a communications connection as in independent claim 17. The Examiner believes that column 4, lines 41-65 of Wang disclose that the information received from the infrared transceiver 662 is used to establish communications. However, this passage merely describes transmitting an approval message from the PEAD in order to approve a transaction requested by the requesting device 202. The identification is included as part of this approval message. There is no suggestion that the approval message initiates any further communication via the infrared port, nor that any further communication is required to complete the transaction.

#### **The Issue of Anticipation**

The Examiner is reminded that the anticipation analysis requires a positive answer to the question of whether the system of Wang would infringe the claims of this application, if it were later.

Independent claim 1 of the present application claims:

**"A portable communications device comprising means for communicating with a second device and identification means separate to said communications means, said identification means arranged to provide information on said portable communications device, wherein said information from said identification means is obtainable by said second device, and in use, is used to establish a communications connection between said communication means and said second device."**

Since the claimed features are not present in the system of the reference Wang, there can be no infringement of the subject claims. Therefore the teaching of Wang does not support the rejection based on anticipation with respect to any of the claims. Equivalent language appears in independent claims 16 and 17.

These arguments apply equally to the rejected dependent claims.

### **The Issue of Obviousness**

It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application.

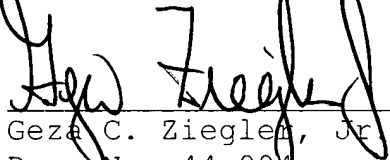
Applicant submits that the above described deficiencies of the primary reference Wang are not remedied by the proposed combination with the teaching of the reference McGregor, et al. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Wang or McGregor, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.

The above arguments apply equally to the rejected dependent claims.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
Geza C. Ziegler, Jr.  
Reg. No. 44,004

1 Dec 2005  
Date

Perman & Green, LLP  
425 Post Road  
Fairfield, CT 06824  
(203) 259-1800  
Customer No.: 2512

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 12/01/2005

Signature:   
Person Making Deposit